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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,716	12/05/2003	Renato Colombo	9331.18512	1740

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EXAMINER

DEVORE, PETER T

ART UNIT PAPER NUMBER

3751

DATE MAILED: 04/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

5P

Office Action Summary	Application No.		Applicant(s)	
	10/728,716		COLOMBO ET AL.	
	Examiner		Art Unit	
	Peter T deVore		3751	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 3 and 4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 5-32 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>5/28/04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

This application contains claims directed to the following patentably distinct species of the claimed invention: Species 1, directed to a valve with couplings integral with the valve body; Species 2, directed to a valve with couplings welded to the valve body; and Species 3, directed to a valve with couplings threaded to the valve body;

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 5-11, 20, and 22-28 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record

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showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

During a telephone conversation with Mr. Marion on 3/24/05 a provisional election was made with traverse to prosecute the invention of Species 1, claims 1, 2, and 5-32. Affirmation of this election must be made by applicant in replying to this Office action. Claims 3 and 4 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 5, 12, 13, and 20-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Demler.

The Demler reference discloses a valve (Figure 26) comprising a valve body 82 with integral first and second couplings 81 attached at the inlet and outlet thereof, and malleable sleeves 3 for connection of the couplings to conduits 1 and 2. Regarding claims 5, 13, and 22, the valve body further includes flow control mechanism 87.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6, 7, 14, 15, 23, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Demler in view of Woods.

The Demler reference discloses a valve as discussed supra, but does not disclose that the flow control mechanism is a top entry ball valve. Instead it is a top entry gate valve. However, the Woods reference discloses a similar valve having a ball valve as its flow control mechanism. It would have been obvious to substitute a ball valve for the gate valve of the Demler device in view of Woods wherein so doing would constitute mere substitution of one functionally equivalent flow control mechanism in the art for another and the selection of any of these flow control mechanisms would work equally well in the Demler device.

Claims 8, 9, 16, 17, 25, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Demler in view of Cannon.

The Demler reference discloses a valve as discussed supra, but does not disclose that the inner and outer diameters of the couplings are equivalent to those of the conduits. However, the Cannon reference discloses a similar connection between a coupling and a conduit which employ a malleable sleeve 1 and which is used when the coupling and conduit have equivalent diameters. It would have been obvious to

substitute a connection mechanism as taught by Cannon for the connection mechanism in the Demler device to accommodate conduits with equivalent diameters as the couplings of the Demler device.

Claims 10, 11, 18, 19, and 27-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Demler in view of Pearl.

The Demler reference discloses a valve as discussed supra, but does not disclose that the valve body and couplings are annealed. However, the Pearl reference discloses a similar connection wherein the body/coupling 2 is annealed (see col. 10, lines 44-46) to soften the coupling for its interface with sleeve 3. It would have been obvious to anneal the body/coupling of the Demler device in view of Pearl to soften the coupling for its interface with the malleable sleeve. Regarding claim 29, the claimed method is inherently performed during the normal fabrication of the modified Demler device. Regarding claims 30-32, although Demler/Pearl remain silent as to the annealing temperature and time, it would have been obvious to anneal at about 520 Celsius for about 2 hours since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 2336.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter T deVore whose telephone number is (571) 272-4884. The examiner can normally be reached on Monday to Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Justine Yu can be reached on (571) 272-4835. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pd *PJ*

Patricia J. Miller